



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

Paper No. 7

FISH & NEAVE
1251 AVENUE OF THE AMERICAS
50TH FLOOR
NEW YORK, NY 10020-1105

COPY MAILED

OCT 24 2002

OFFICE OF PETITIONS

In re Application of
Andrew C. Gilbert,
Andrew Stergiopoulos and
William P. Tselepis
Application No. 10/047,607
Filed: January 14, 2002
Attorney Docket No. CF-034
Title: SYSTEMS AND METHODS FOR
ELECTRONIC TRADING THAT PERMIT
PRINCIPAL/BROKER TRADING

:
:
: DECISION REFUSING STATUS
: UNDER 37 C.F.R. § 1.47(a)
:
:
:
:
:
:
:

This is a decision on the petition under §1.47(a), filed July 12, 2002.

The above-identified application was filed on January 14, 2002, without an executed oath or declaration, and naming Andrew C. Gilbert, Andrew Stergiopoulos and William P. Tselepis as joint inventors. Accordingly, on February 13, 2002, the Office mailed a "Notice to File Missing Parts of Nonprovisional Application," requiring applicants to submit an executed oath or declaration and the surcharge under §1.16(e) for its late filing. This Notice set a two month period for reply, with extensions of time obtainable under §1.136(a).

Applicants replied filing the instant petition under §1.47, with a declaration executed by the legal representatives of inventors Stergiopoulos and Tselepis. (All three inventors are deceased). This reply was made timely by an accompanying petition for a three-month extension of time. Applicants state that acceptance of the declaration under §1.47 is proper because the legal representative of inventor Gilbert has been identified, but she refuses to sign. Accompanying the petition is a copy of a letter sent to the nonsigning legal representative requesting her signature. Petitioner states that a copy of the declaration and power of attorney was sent with this letter.

RELEVANT STATUTES, REGULATIONS AND PROCEDURES

37 CFR 1.42:

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

MPEP 409.03(c) Legal Representatives of Deceased Inventor Not Available:

37 CFR 1.47 applies where a known legal representative of a deceased inventor cannot be found or reached after diligent effort, or refuses to make application.

37 CFR 1.47 Filing when an inventor refuses to sign or cannot be reached.

(a) If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the non-signing inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in § 1.17(h), and the last known address of the non-signing inventor. The non-signing inventor may subsequently join in the application by filing an oath or declaration complying with § 1.63.

37 CFR 1.64 Person making oath or declaration.

(a) The oath or declaration (§ 1.63), including any supplemental oath or declaration (§ 1.67), must be made by all of the actual inventors except as provided for in §§ 1.42, 1.43, 1.47, or § 1.67.

(b) If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, 1.47, or § 1.67), the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor is required to state. If the person signing the oath or declaration is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence, and mailing address of the legal representative.

ANALYSIS

The declaration has been reviewed and found in compliance with §§ 1.47, 1.63 and 1.64. The petition includes payment of the petition fee and the last known address of the deceased inventor and of the legal representative. However, the petition is not grantable because petitioner has not submitted adequate proof of refusal.

Before a refusal can be alleged, applicants must demonstrate that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the legal representative. The legal representative is making application for patent on behalf of the deceased inventor and should be presented with the same documents that the inventor would have been presented with. A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure

ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956). See MPEP 409.03(d).

Rule 47 applicants have only offered evidence showing that the declaration and power of attorney were presented to the legal representative for deceased inventor Gilbert. Thus, on renewed petition, applicants must establish that the entire application package, including specification, claims and drawings, was presented to the legal representative and she refused to sign. A copy of the application papers should be sent by certified mail return-receipt requested to the last known address of the legal representative, or, if the legal representative is represented by counsel, to the address of the non-signing inventor's attorney. Documentary evidence, including copies of the transmittal cover letters and return mail receipts, should be made part of the record.

CONCLUSION

In view thereof, the petition under 37 CFR 1.47(a) is **DISMISSED**.

Rule 47 applicant is given **TWO MONTHS** from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted above, except that the reply may include an oath or declaration executed by the legal representative of the deceased inventor. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 CFR 1.136(a).

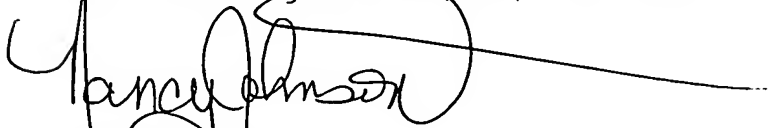
Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions
ATTN: NANCY JOHNSON

By hand: Office of Petitions
2201 South Clark Place
Crystal Plaza Four, Suite 3C23
Arlington, VA

Telephone inquiries related to this decision may be directed to the undersigned at (703) 305-0309.



Nancy Johnson
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy